

REMARKS

Claim Amendments

Claims 66-75 have been cancelled without prejudice.

Claims 1 and 29-32 have been amended to substitute a semi-colon for a comma at the end of each clause describing a layer. Claim 29 has been further amended to delete an extraneous comma. Claim 32 has been further amended to spatially separate the layer-reciting clauses.

Claims 30 and 31 have been further amended to specify the positional relationship between the recited layers. Specifically, these claims been amended to specify that "the second layer is disposed between and in contiguous contact with the coating layer and the adhesive layer". Support for this amendment may be found, at least, in claim 1 as filed.

Claim 2 has been amended for consistency with claim 1 from which it depends. Specifically, claim 2 has been amended to make clear that the 1,3-hydroxybenzene is not itself present in the claim 1 coating layer but that some of the structural units present in the coating layer block copolyestercarbonate are derived from the 1,3-hydroxybenzene. Support for this amendment may be found in claim 1 as filed.

Claim 19 has been amended for consistency with claim 1 from which it depends. Specifically, claim 19 has been amended to state that "the alkenyl aromatic compound comprises styrene" rather than "the alkenyl aromatic compound comprises structural units derived from styrene".

Claim 49 has been amended to make abundantly clear that the recited block copolymer (which comprises a block comprising structural units derived from styrene, and a block comprising a thermoplastic polyurethane) is distinct from the polyurethane adhesive material of claim 32, from which claim 49 depends.

Claim 54 has been amended to make clear that the peel force limitation is a property of the multilayer article. This amendment restores claim 54 to its original form.

Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 1-17, 19, 21, 22, 27, 29-50, 52, 54, 5, 60, and 62-75 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4/18/2007 Office Action, page 2, third paragraph. In particular, the Examiner states,

In each instance, the recited second layer is unclear substantively as well as what applicants are intending structurally. In other words, as written, the second layer can be envisaged in several ways. As one example, the adhesive layer may be interpreted as comprising separate adhesive material *and* a separate resinous copolymer or *in the alternative*.

4/18/2007 Office Action, page 2, fourth paragraph (emphasis in original). Applicant respectfully traverses this rejection to the extent it may be applicable to the claims as currently amended.

Given that claims 23 and 56-59 were canceled in Applicant's 4/4/2005 Amendment, Applicant's response assumes that the rejection was intended to apply to claims 1-17, 19, 21, 22, 27, 29-50, 52, 54, 5, 60, and 62-75.

Applicant's attorney is grateful to the Examiner for the courtesy of the telephonic interview conducted on May 2. In that interview, the Examiner explained her concern that it is not clear whether Applicant's "second layer" includes Applicant's "adhesive layer", or whether the "second layer" and the "adhesive layer" are distinct.

Applicant respectfully submits that it was already clear that the "second layer" and the "adhesive" layer are distinct in each of Applicant's previously presented independent claims. However, in order to expedite prosecution of the case, Applicant has amended independent claims 1 and 29-32 so that the recitations of individual layers are not only spatially separated, but also separated by semicolons. These amendments leave absolutely no doubt that the "second layer" and the "adhesive layer" are distinct layers in each of Applicant's independent claims. Accordingly, and in view of the present cancellation of claims 66-75, Applicant respectfully requests the reconsideration and

withdrawal of the rejection of claims 1-17, 19, 21, 22, 27, 29-50, 52, 54, 5, 60, and 62-65 under 35 U.S.C. § 112, second paragraph.

Anticipation Rejection Over Asthana

Claims 1-17, 19, 21, 22, 27, 29-50, 52, 54, 55, 60, and 62-75 stand rejected under 35 U.S.C. § 102(e), as allegedly anticipated by U.S. Patent Application Publication No. US 2003/0175488 of Asthana et al. ("Asthana"). 4/18/2007 Office Action, page 3, first full paragraph. Applicant respectfully traverses this rejection to the extent it may be applicable to the claims as currently amended.

Anticipation requires that all of the limitations of the claim be found within a single prior art reference. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991). For a rejection under section 102 to be proper, the cited reference must clearly and unequivocally disclose the claimed subject matter without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference. *In re Arkley*, 172 USPQ 524, 526 (C.C.P.A. 1972).

Applicant respectfully asserts that independent claims 1 and 29-32 are not anticipated by Asthana because Asthana does not teach the adhesive layer of those claims. The adhesive layers of claims 1 and 29-32 each have positional and compositional limitations. The positional limitations of claims 1 and 29-32 require that the adhesive layer be in contiguous contact with the second layer and the substrate layer. The compositional limitations of claims 1, 29, 30, and 32 require, inter alia, that the adhesive layer comprise a resinous copolymer comprising structural units derived from an alkenyl aromatic compound and a conjugated diene. The compositional limitations of claim 31 requires, inter alia, that the adhesive layer comprise a block copolymer comprising a thermoplastic polyurethane block and at least one block comprising structural units derived from styrene.

The Examiner has not established that Asthana teaches a layer meeting both the positional and compositional limitations of Applicant's independent claim adhesive

layers. The Examiner has expressly cited page 10, paragraph [0111] of Asthana (4/18/2007 Office Action,, page 4, fourth paragraph), but the "adhesive coating" discussed in that paragraph (which is distinct from the "tie-layer" discussed elsewhere; see paragraph [0109]) is described as a "clear exterior urethane". There is no teaching that the paragraph [0111] "adhesive coating" comprises Applicant's claim 1, 29, 30, and 32 resinous copolymer comprising structural units derived from an alkenyl aromatic compound and a conjugated diene. Nor is there any teaching that the paragraph [0111] "adhesive coating" comprises Applicant's claim 31 " block copolymer comprising a thermoplastic polyurethane block and at least one block comprising structural units derived from styrene". So, the "adhesive coating" of Asthana, page 10, paragraph [0111] does not satisfy the compositional limitations of Applicant's independent claim adhesive layers.

By stating that "the tie-layer is comprised of a thermoplastic resin selected from the group of an ethylene/vinyl acetate copolymer (EVA), a polyester, a copolyester, a copolyamide, a polyurethane (TPU), a styrene block copolymers (SEBS), a modified SBES, or blends thereof" (4/18/2007 Office Action, page 4, fourth paragraph), the Examiner appears to be implicitly referring to Asthana at page 7, paragraph [0074]. However, the "tie-layer" described in that paragraph is expressly "for use in enhancing the adhesion between the coating layer comprising resorcinol arylate polyester chain members, and a substrate layer comprising polyestercarbonate." Asthana, page 10, paragraph [0065]. Thus, the "tie-layer" of Asthana paragraphs [0065] and [0074] is in direct contact with the contact with the "coating layer comprising resorcinol arylate polyester chain members" and it is therefore distinguished from Applicant's independent claim adhesive layers which are separated from the coating layer comprising block copolyestercarbonate by the second layer comprising carbonate structural units. So, the "tie layer" of Asthana, page 7, paragraph [0074] does not satisfy the positional limitations of Applicant's independent claim adhesive layers.

In short, the Examiner has not demonstrated that Asthana teaches a layer that satisfies both the compositional and positional limitations of the adhesive layers of Applicant's independent claims 1 and 29-32. Accordingly, these independent claims are

not anticipated by Asthana. Given that claims 66-75 have been canceled, and given that claim 2-17, 19, 21, 22, 27, 33-50, 52, 54, 55, 60, and 62-65 each depend from or further limit either claim 1 or claim 32, Applicant respectfully requests the reconsideration and withdrawal of the rejection of claims 1-17, 19, 21, 22, 27, 29-50, 52, 54, 55, 60, and 62-65 under 35 U.S.C. § 102(e) over Asthana.

Nonstatutory Double Patenting Rejections

Claims 1-17, 19, 21, 22, 27, 29-50, 52, 54, 55, 60, and 62-75 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 2, 4, 5-9, 12-18, 20-23, 2-34, and 40-47 of Asthana (Application No. 10/210,746). 4/18/2007 Office Action, page 7, second paragraph. Applicant respectfully traverses the rejection to the extent it may be applicable to the claims as currently amended.

An obviousness-type double patent rejection, like any other obviousness rejection, requires the examiner to meet the burden of establishing a prima facie case of obviousness. Establishing a prima facie case of obviousness requires that all limitations of the claim be taught or suggested by the prior art. *See, e.g.,* MPEP 2143.03; *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003); *In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974).

As explained in detail above, each of Applicant's independent claims 1 and 29-32 recites an adhesive layer that has both positional and compositional limitations. Also as explained in detail above, the Examiner has failed to establish that a layer satisfying these limitations is taught or suggested anywhere in the entire disclosure of Asthana. It is therefore clear that the Examiner has failed to establish that a layer satisfying these limitations is taught or suggested by claims 2, 4, 5-9, 12-18, 20-23, 2-34, and 40-47 of Asthana. Accordingly, a prima facie case of obviousness has not been established against claims 1 and 29-32, and these claims are patentable over Asthana. Given that claims 66-75 have been canceled, and given that claim 2-17, 19, 21, 22, 27, 33-50, 52, 54, 55, 60, and 62-65 each depend from or further limit either claim 1 or claim 32, Applicant respectfully requests the reconsideration and withdrawal of the provisional rejection of

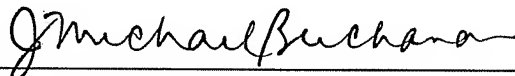
claims 1-17, 19, 21, 22, 27, 29-50, 52, 54, 55, 60, and 62-65 under the judicially created doctrine of obviousness-type double patenting over claims 2, 4, 5-9, 12-18, 20-23, 2-34, and 40-47 of Asthana.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicant. Accordingly, reconsideration and allowance is requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 50-3621 maintained by Assignee.

Respectfully submitted,

CANTOR COLBURN LLP
Applicant's Attorneys

By: 
J. Michael Buchanan
Registration No. 44,571

Date: May 11, 2007
CANTOR COLBURN LLP
55 Griffin Road South
Bloomfield, CT 06002
Telephone: (860) 286-2929
Facsimile: (860) 286-0115
Customer No.: 23413